



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,105	09/22/2000	Chen Feng	TELNP215US	9584

7590 10/21/2002

Himanshu S Amin Esq
Amin Eschweiler & Turocy LLP
24th Floor National City Center
1900 East 9th Street
Cleveland, OH 44114

EXAMINER

SHAFER, RICKY D

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	09/668,105	Applicant(s)	FEING
Examiner	R.D.SHAFFER	Group Art Unit	2872

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

Responsive to communication(s) filed on 4/11/02 AND 7/29/02
 This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

Claim(s) 1 - 25 is/are pending in the application.
Of the above claim(s) 6 - 16 AND 19 - 25 is/are withdrawn from consideration.
 Claim(s) _____ is/are allowed.
 Claim(s) 1 - 5, 17 AND 18 is/are rejected.
 Claim(s) _____ is/are objected to.
 Claim(s) _____ are subject to restriction or election requirement

Application Papers

The proposed drawing correction, filed on _____ is approved disapproved.
 The drawing(s) filed on _____ is/are objected to by the Examiner
 The specification is objected to by the Examiner.
 The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
 All Some* None of the:
 Certified copies of the priority documents have been received.
 Certified copies of the priority documents have been received in Application No. _____.
 Copies of the certified copies of the priority documents have been received
in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ International Summary, PTO-413
 Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152
 Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

Art Unit: 2872

1. Applicant's election of species "A", depicted by Fig. 4, in Paper No. 7 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 6-16 and 19-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7.

3. Applicant's arguments filed 4/11/02 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art references to Shepard ('711), Bressers ('295) and Ogura et al ('560) do not anticipate the claims under section 102 because the references do not disclose a housing with an opening "for receiving light from a scanned dataform" , the examiner states a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 2872

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bressers ('295).

Bressers discloses an assembly comprising a housing (H) with an opening (0), an image sensor (13) with an aperture (A) and a prism (6). Note fig. 1.

6. Claims 1-5, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogura et al (560).

Ogura et al discloses an assembly comprising a housing (72, 73) with an opening, an image sensor (2) with an aperture, and a prism (G4, 65). Note by example only, figures 11 and 23.

7. Claims 1-5, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Shepard ('711).

Shepard discloses an assembly comprising a housing (19) with an opening (26), an image sensor (42) with an aperture (56) and a prism (22). Note figures 1-4.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

Art Unit: 2872

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication should be directed to R.D. Shafer at telephone number (703) 308-4813.

RDS

October 15, 2002

R.D. Shafer
RICKY D. SHAFER
PATENT EXAMINER
ART UNIT 2872